

Application No. 09/362,189
Attorneys' Docket No. 045112-014

47. (Amended) A pesticidal composition comprising, in admixture with an acceptable carrier, benzyl alcohol, pyrethrum, tetrahydrofurfuryl alcohol (THFA), 2-(2-amino-3-methoxyphenyl)-4-oxo-4H-[1]benzopyran or 2'-amino-3'-methoxy-flavone (PD 98059), and trans-anethole.

REMARKS

Claims 17 and 47 are pending in the application. Claims 5, 6, 8, 10, 16, 18-46, and 48-52 are canceled without prejudice to, or disclaimer of, the subject matter they contain or the right to file continuing applications therefor. Claims 17 and 47 are amended to encompass infringing subject matter. No new matter is introduced into the application.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

Applicants respectfully submit that entry of the above claim amendments is proper under 37 C.F.R. § 1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout the prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal. Thus, entry of the foregoing amendments, reconsideration and reexamination of the claimed subject matter are respectfully requested.

Applicants acknowledge that previous a Office Action (Paper No. 11) has made the restriction requirement final. Applicants respectfully maintain its traversal for the reasons of record.

THE REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 6, 10 and 47 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection to the extent it now applies to the claims as amended. Applicants have canceled Claims 6 and 10, without prejudice to, or disclaimer of, the subject matter they contain, thereby rendering the rejection moot with respect to Claims 6 and 10. Solely in an effort to advance prosecution, claim 47 has been amended to more clearly describe the subject matter sought to be patented. In particular,

Application No. 09/362,189
Attorneys' Docket No. 045112-014

the chemical name of PD 98059, 2-(2-amino-3-methoxyphenyl)-4-oxo-4H-[1]benzopyran or 2'-amino-3'-methoxy-flavone, has been set out in the claim. Support for this amendment can be found on page 7, lines 14 and 15 of the specification. Accordingly, the rejection under §112, second paragraph, should be reconsidered and withdrawn and such favorable action is requested.

THE REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 6, 10, 17 and 47 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection to the extent it can be applied to the pending claims. As previously noted, Claims 6 and 10 are canceled without prejudice to, or disclaimer of, the subject matter they contain, thereby rendering this rejection moot with respect to these claims. With respect to Claim 47, Applicants respectfully submit that there is support in the specification on page 37, Example 21, for the composition of Claim 47. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

THE REJECTIONS UNDER 35 U.S.C. 102(b)

Claims 6, 10 and 17 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Gordon et al. (EP 0 262 885). Applicants respectfully traverse this rejection for at least the following reasons. As presented herein, Gordon et al. neither disclose nor teach all the features of Applicants' invention as claimed. At best, Gordon et al. describe a pediculicidal/ovicidal shampoo composition including the following ingredients combined in a four phase methodology: deionized water, edetate disodium USP, ethylene oxide, n-decanol, butylated hydroxytoluene, pyrethrins petroleum distillate, piperonyl butoxide, benzyl alcohol, Octoxynol 9 NE, perfume oil, isopropyl alcohol, and ammonium lauryl ether sulfate. Although, Gordon et al. disclose benzyl alcohol with pyrethrin in combination with many other ingredients, the disclosed data in Gordon et al. does not teach that a composition, in order to be pesticidally effective, consists essentially of benzyl alcohol and pyrethrum, as in the presently claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections.

Application No. 09/362,189
Attorneys' Docket No. 045112-014

THE REJECTIONS UNDER 35. U.S.C. §103(a)

Claims 6, 10 and 17 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Locher et al. (U.S. Patent No. 3,445,565) in view of Lover et al. (U.S. Patent No. 4,368,207) and Schraufstatter et al. (U.S. Patent No. 2,945,782). Applicants respectfully traverse this rejection for at least the following reasons.

The combined cited references do not teach the unexpected enhanced results of the claimed invention. Locher et al. merely disclose a composition for combating insects in the fur of domestic animals including pyrethrum extract and piperonyl butoxide. Locher et al. neither teach nor disclose combining pyrethrum and benzyl alcohol together. Lover et al. does not remedy the deficiencies of Locher et al. Lover et al. merely disclose the use of certain higher alcohols (e.g., benzyl alcohol) alone or in combination with other alcohols as toxicants for lice and/or their ova. Lover et al. would not have taught or motivated one of ordinary skill in the art to combine pyrethrum and benzyl alcohol. Furthermore, Schraufstatter et al., merely discloses benzyl alcohol and isopropyl alcohol as a disinfectant. As such, one of ordinary skill in the art would not have been motivated at the time of the invention to combine pyrethrum and benzyl alcohol as claimed by Applicant.

It would not have been obvious that the combination(s) would work, let alone, provide the unexpected enhanced effects of the claimed invention. Applicants' invention stems from the recognition that compounds of naturally occurring plant essential oils unexpectedly exhibit synergistic and residual effects on pesticidal agents. The synergistic effects of the claimed invention allows for a decrease in the necessary amount of a pesticidal agent while still maintaining the same strong ability to kill pests. The residual effects of the claimed invention increases the efficacy of the pesticidal composition over extended time periods. As previously noted, Examples 1 through 24, starting at page 16 of the specification, illustrate pesticidal compositions having synergism, and residual effects for varying time periods ranging from one hour up to sixty days. In particular, Applicants' invention reveals pyrethrum's synergistic effect on benzyl alcohol resulting in 100% pesticidal mortality for over 30 days. Locher et al. in view of Lover et al. neither teach nor disclose pediculicidal/ovicidal efficacy using pyrethrum and benzyl alcohol together, nor do they teach extended efficacy beyond one hour and twenty four hour time intervals, respectively. Moreover, the synergistic and residual effects of the claimed invention increases and enhances the biological activity of the pesticidal agents. The

Application No. 09/362,189
Attorneys' Docket No. 045112-014


combination of references do not teach Applicants' synergistic compositions as recited in the claims. Applicants respectfully request reconsideration and withdrawal of the rejections.

CONCLUSION

Early consideration and prompt allowance of the pending claims are respectfully requested. If anything could be done to place this application in condition for allowance, e.g., by Examiner's Amendment, Applicants respectfully request that the Examiner contact the undersigned representative at the telephone number listed below.

To the extent necessary, please grant any extension of time deemed necessary for entry of this communication. Please charge any deficient fees, or credit any overpayment of fees, to Deposit Account 500417.

Respectfully submitted,


Kelli N. Watson
Registration No. 47,170

Willem F. Gadiano
Registration No. 37,136

DATE: OCTOBER 17, 2002
MCDERMOTT, WILL & EMERY
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
Telephone: (202) 756-8351
Facsimile: (202) 756-8087

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 305-3592 on the date indicated below, with a coversheet addressed to Assistant Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C., 20231.

Date: October 17, 2002

By: 
Kelli N. Watson, Registration No. 47,170

Application No. 09/362,189
Attorneys' Docket No. 045112-014

ATTACHMENT**VERSION WITH MARKINGS TO SHOW CHANGES MADE****IN THE CLAIMS**

Claims 5, 6, 8, 10, 16, 18-46, and 48-52 are canceled, without prejudice to, or disclaimer of, the subject matter they contain.

Claims 17 and 47 are amended, as follow.

5. (Canceled)
6. (Canceled)
8. (Canceled)
10. (Canceled)
16. (Canceled)
17. (Amended) A pesticidal composition consisting essentially of[comprising, in admixture with an acceptable carrier,] benzyl alcohol and pyrethrum, in admixture with an acceptable carrier.

18. (Canceled)
19. (Canceled)
20. (Canceled)
21. (Canceled)
22. (Canceled)
23. (Canceled)
24. (Canceled)
25. (Canceled)
26. (Canceled)
27. (Canceled)
28. (Canceled)
29. (Canceled)
30. (Canceled)
31. (Canceled)
32. (Canceled)
33. (Canceled)

Application No. 09/362,189
Attorneys' Docket No. 045112-014

34. (Canceled)
35. (Canceled)
36. (Canceled)
37. (Canceled)
38. (Canceled)
39. (Canceled)
40. (Canceled)
41. (Canceled)
42. (Canceled)
43. (Canceled)
44. (Canceled)
45. (Canceled)
46. (Canceled)
47. (Amended) A pesticidal composition comprising, in admixture with an acceptable carrier, benzyl alcohol, pyrethrum, tetrahydrofurfuryl alcohol (THFA), 2-(2-amino-3-methoxyphenyl)-4-oxo-4H-[1]benzopyran or 2'-amino-3'-methoxy-flavone (PD 98059), and trans-anethole.
48. (Canceled)
49. (Canceled)
50. (Canceled)
51. (Canceled)
52. (Canceled)